

ESTTA Tracking number: **ESTTA374896**

Filing date: **10/25/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91193133
Party	Plaintiff Piggyback Interactive Limited
Correspondence Address	Mark H. Tidman Baker & Hostetler LLP Washington Square, Suite 1100, 1050 Connecticut Avenue, N.W. Washington, DC 20036 UNITED STATES mtidman@bakerlaw.com
Submission	Other Motions/Papers
Filer's Name	Mark H. Tidman
Filer's e-mail	trademarks@bakerlaw.com
Signature	/Mark H. Tidman/
Date	10/25/2010
Attachments	4665_001.pdf (7 pages)(305748 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK
TRIAL AND APPEAL BOARD**

Piggyback Interactive Limited)	
)	
v. Opposer)	Proceeding No. 91193133
)	Mark: PIGGEEBACK
)	Application No.: 78/427,793
Graeme C. Revell and Ashley M. Revell)	
)	
Applicants.)	

Graeme C. Revell and Ashley M. Revell)	
)	
v. Counterclaim Petitioner)	Registration No. 3,264,264
)	Mark: PIGGYBACK
)	
Piggyback Interactive Limited)	
)	
Counterclaim Respondent.)	

Atty Dkt.No: 043082.000001

**COMMUNICATION REGARDING WITHDRAWAL OF
COUNTERCLAIM FOR CANCELLATION**

Piggyback Interactive Limited, through undersigned counsel, hereby submits that the withdrawal of the counterclaim for cancellation filed herein by counterclaim petitioner on October 15, 2010 is by rule a ***with prejudice*** withdrawal.

Specifically, pursuant to Rule 2.114(c), a petition for cancellation "may not be withdrawn without prejudice except with a written consent of the registrant." Counsel for counterclaim petitioner, Rod S. Berman, is well aware of this rule and specifically requested consent to withdraw the proceeding without prejudice. Such consent was expressly denied. (See attached correspondence). Further, upon receipt of the Withdrawal of Counterclaim for Cancellation Without Prejudice, undersigned counsel sought to have Mr. Berman correct the matter. Such

request has gone without response, illustrating Mr. Berman's apparent intent to circumvent the Board's rules.

Under the circumstances, and in view of the fact that no consent has been provided, the counterclaim for cancellation should be dismissed *with prejudice*.

Respectfully submitted,




October ~~26~~ 2010

By: Mark H. Tidman
BAKER & HOSTETLER LLP
1050 Connecticut Ave. N.W.
Suite 1100
Washington, D.C. 20036
(202) 861-1500

CERTIFICATE OF SERVICE

I hereby certify that on this 25th day of October, 2010 a true copy of the foregoing Communication Regarding Withdrawal of Counterclaim for Cancellation was served via first-class mail postage prepaid upon the following:

Rod S. Berman, Esq.
Jeffer Mangels Butler & Mitchell LLP.
1900 Avenue of the Stars, 7th Floor
Los Angeles, CA 90067



Mark H. Tidman

Tidman, Mark H.

From: Tidman, Mark H.
Sent: Thursday, October 21, 2010 10:07 PM
To: Berman, Rod S.
Cc: Shireen.Peermohamed@harbottle.com; Bromall, Jessica
Subject: RE: Piggyback - Piggeeback proceeding

Rod - We received your withdrawal of the counterclaim without prejudice. As you know, you are required by rule to have consent for dismissal without prejudice. Knowing this requirement, you requested such consent, and we explicitly denied it. We assume that your filing was inadvertently erroneous and not an underhanded attempt to circumvent the Board's rules. As such, please advise by c.o.b. Friday whether you will correct the filing to make change your dismissal to a "with prejudice" basis. In the absence of your correction of this matter, we will act accordingly. Mark

From: Tidman, Mark H.
Sent: Thursday, October 14, 2010 2:51 PM
To: Berman, Rod S.
Cc: Shireen.Peermohamed@harbottle.com; Bromall, Jessica
Subject: RE: Piggyback - Piggeeback proceeding

Rod - First, your premise does not make sense. That is, you are apparently contemplating some hypothetical lawsuit that may be filed in the future. However, preserving your right to re-institute a cancellation proceeding at the PTO downstream is of no consequence, since such proceeding would simply be suspended pending the outcome of any such hypothetical lawsuit, and the presumptions provided by such registration would remain in place despite the suspended filing. Therefore, whatever deterrent effect you are trying to create is non-existent. Further, and most importantly, our dismissal was final, and yours must be as well. Mark

From: Berman, Rod S. [RXB@JMBM.com]
Sent: Thursday, October 14, 2010 2:13 PM
To: Tidman, Mark H.
Cc: Shireen.Peermohamed@harbottle.com; Bromall, Jessica; Berman, Rod S.
Subject: RE: Piggyback - Piggeeback proceeding

We are prepared to dismiss the cancellation petition without prejudice to our client's right to challenge it again if in the future your client takes any action against our client or any action with respect to our client's mark. Please advise if your client will stipulate to such a consent without prejudice. Rod

From: Tidman, Mark H. [mailto:mtidman@bakerlaw.com]
Sent: Thursday, October 14, 2010 8:04 AM
To: Berman, Rod S.
Cc: Shireen.Peermohamed@harbottle.com; Bromall, Jessica
Subject: RE: Piggyback - Piggeeback proceeding

Rod - Frankly, your requests are confusing. Obviously, the Board cannot award money. Further, our client has priority of rights in its mark over your client in the U.S. and elsewhere in the world, and cancellation of our client's U.S. registration will not change that reality. We also view your cancellation proceeding as entirely lacking merit and will defend it, respond to your discovery should you file a motion to compel, serve discovery of our own etc, if we need to do so. Further, we will simply re-file in the unlikely event that you do succeed many months and dollars from now. However, we have dismissed the opposition with prejudice. Your client is going to get its

10/25/2010

registration. It is difficult to imagine why your client would want to expend resources on something that will not impact its rights in any way and will only provoke our client to consider other more meaningful action. At any rate, do what you will. I suggest that it is in your client's best interest to walk away with its registration and be happy. Mark

From: Berman, Rod S. [RXB@JMBM.com]
Sent: Thursday, October 14, 2010 9:16 AM
To: Tidman, Mark H.
Cc: Shireen.Peermohamed@harbottle.com; Bromall, Jessica; Berman, Rod S.
Subject: Re: Piggyback - Piggeeback proceeding

Please advise if your client will voluntarily cancel its registration with prejudice. Rod

 Sent from my BlackBerry Wireless Handheld

From: Tidman, Mark H.
To: Berman, Rod S.
Cc: Shireen Peermohamed ; Bromall, Jessica
Sent: Thu Oct 14 06:31:18 2010
Subject: RE: Piggyback - Piggeeback proceeding
 No

From: Berman, Rod S. [RXB@JMBM.com]
Sent: Wednesday, October 13, 2010 11:36 PM
To: Tidman, Mark H.
Cc: Shireen Peermohamed; Bromall, Jessica; Berman, Rod S.
Subject: RE: Piggyback - Piggeeback proceeding

Dear Mark: Please let me know if your client is prepared to pay our client's fees and costs incurred in connection with the opposition. Rod

From: Tidman, Mark H. [mailto:mtidman@bakerlaw.com]
Sent: Tuesday, October 12, 2010 10:48 AM
To: Berman, Rod S.
Cc: Shireen Peermohamed; Bromall, Jessica
Subject: RE: Piggyback - Piggeeback proceeding

Rod - The dismissal was filed and served yesterday (check Estta). A copy is attached for your reference. We assume your client will likewise withdrawal its cancellation proceeding under the circumstances, and we look forward to your confirmation. Mark

My Bio | Web site | V-card

T 202.861.1670
 F 202.861.1783
 M
www.bakerlaw.com

Mark Tidman
mtidman@bakerlaw.com

Baker & Hostetler LLP
 Washington Square, Suite 1100
 1050 Connecticut Avenue, N.W.
 Washington, D.C. 20036-5304



10/25/2010

From: Berman, Rod S. [mailto:RXB@JMBM.com]
Sent: Tuesday, October 12, 2010 1:39 PM
To: Tidman, Mark H.
Cc: Shireen Peermohamed; Berman, Rod S.; Bromall, Jessica
Subject: FW: Piggyback - Piggyback proceeding

As your client has not dismissed the opposition proceeding, and we have not received responses to our discovery, we are proceeding with a motion to compel. As you know, as your client did not respond to the discovery, all objections are waived. If your client dismisses its opposition today, we will not file our motion. Otherwise, we will file tomorrow. Regards, Rod

From: Tidman, Mark H. [mailto:mtidman@bakerlaw.com]
Sent: Thursday, October 07, 2010 1:39 PM
To: Berman, Rod S.
Cc: Bromall, Jessica; Shireen Peermohamed
Subject: Piggyback - Piggyback proceeding

Dear Rod:

We have not heard from you further regarding the remaining issue of territorial extent of the proposed agreement in the above matter. As you know, our client is not willing to enter into restrictions worldwide in the context of a proceeding pertaining solely to registration in the U.S. Since the parties appear to be at an impasse, as I advised in our telephone conversation earlier today, PIL will be dismissing its opposition to your client's registration of the "piggyback" mark with prejudice. We encourage your client to likewise dismiss its cancellation action with prejudice, as there is nothing to be gained by pursuing it further in terms of the parties' respective rights and/or priority. We would appreciate hearing from you on whether your client intends to likewise dismiss.

Very truly yours,

Mark Tidman

[My Bio](#) | [Web site](#) | [V-card](#)

T 202.861.1670
F 202.861.1783
M
www.bakerlaw.com

Mark Tidman
mtidman@bakerlaw.com

Baker & Hostetler LLP
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304



This email is intended only for the use of the party to which it is addressed and may contain information that is privileged, confidential, or protected by law. If you are not the intended recipient you are hereby notified that any dissemination, copying or distribution of this email or its contents is strictly prohibited. If you have received this message in error, please notify us immediately by replying to the message and deleting it from your computer.

Internet communications are not assured to be secure or clear of inaccuracies as information could be intercepted, corrupted, lost, destroyed, arrive late or incomplete, or contain viruses. Therefore, we do not accept responsibility for any errors or omissions that are present in this email, or any attachment, that have arisen as a result of e-mail transmission.

This email is intended only for the use of the party to which it is addressed and may contain information that is privileged, confidential, or protected by law. If you are not the intended recipient you are hereby notified that any dissemination, copying or distribution of this email or its contents is strictly prohibited. If you have received this message in error, please notify us immediately by replying to the message and deleting it from your computer.

Internet communications are not assured to be secure or clear of inaccuracies as information could be intercepted, corrupted, lost, destroyed, arrive late or incomplete, or contain viruses. Therefore, we do not accept responsibility for any errors or omissions that are present in this email, or any attachment, that have arisen as a result of e-mail transmission.

This email is intended only for the use of the party to which it is addressed and may contain information that is privileged, confidential, or protected by law. If you are not the intended recipient you are hereby notified that any dissemination, copying or distribution of this email or its contents is strictly prohibited. If you have received this message in error, please notify us immediately by replying to the message and deleting it from your computer.

Internet communications are not assured to be secure or clear of inaccuracies as information could be intercepted, corrupted, lost, destroyed, arrive late or incomplete, or contain viruses. Therefore, we do not accept responsibility for any errors or omissions that are present in this email, or any attachment, that have arisen as a result of e-mail transmission.

This email is intended only for the use of the party to which it is addressed and may contain information that is privileged, confidential, or protected by law. If you are not the intended recipient you are hereby notified that any dissemination, copying or distribution of this email or its contents is strictly prohibited. If you have received this message in error, please notify us immediately by replying to the message and deleting it from your computer.

Internet communications are not assured to be secure or clear of inaccuracies as information could be intercepted, corrupted, lost, destroyed, arrive late or incomplete, or contain viruses. Therefore, we do not accept responsibility for any errors or omissions that are present in this email, or any attachment, that have arisen as a result of e-mail transmission.